

### Remarks

**Status of the Claims.** Claims 1-48 are pending. Claims 1-48 were rejected. Claims 1 and 43 were amended to delete certain terms where  $N(A^1-R^1)(A^2-R^2)$  defined some ring systems. Claim 45 was amended to delete "substance abuse" and "post-traumatic stress syndrome."

**Rejection under 35 USC 112, first paragraph.** The examiner rejected claims 1 and 43, arguing that the claim term for " $A^1-R^1$  and  $A^2-R^2$  forming rings" were not enabled throughout the scope of the term. The examiner pointed out that the specification disclosed only four examples for this claim term.

The applicants have amended the claim to correspond to the rings systems disclosed.

The applicants believe the basis for the rejection based on enablement for " $A^1-R^1$  and  $A^2-R^2$  forming rings" has been removed and respectfully request the examiner to withdraw the rejection.

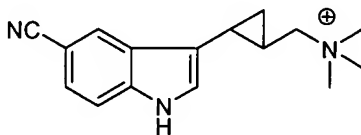
The examiner also rejected claims 45 and 46 as not being enabled for "substance abuse" or "post-traumatic stress disorder."

Claim 45 was amended to delete the terms for "substance abuse" and "post-traumatic stress disorder." The terms for "substance abuse" and "post-traumatic stress disorder" do not occur in claim 46. The applicants respectfully request that the examiner clarify or withdraw the rejection for this claim.

The applicants believe the basis for the rejection based on enablement for claims 45 and 46 has now been removed and respectfully request the examiner to withdraw this rejection.

**Rejection under 35 USC 112, second paragraph.** The examiner rejected claims 1 and 43 and all depending claims as being indefinite for "N" being "bonded to 4 substituents," arguing that valency does not permit 4 bonds to nitrogen. The applicants respectfully traverse.

An amine can be bonded to 4 substituents, as in the case of quarternary salts or N-oxides. Mattson et al. (WO 02/079152, published October 10, 2002) discloses such a quarternary salt as example 187. The current claim term where N is bonded to 4 substituents relates to such quarternary compounds.



The examiner also rejected claims 1 and 43 for “unclear scope” in reciting “what was excluded rather than defining what was invented.” The applicants respectfully traverse.

The examiner cited *In re Schechter*, but misconstrued the facts in that case. In *Schechter*, the applicant claimed an “alkenyl radical other than 2-butenyl and 2,4-pentadienyl.” This claim term was indefinite because the scope of alkenyls was unlimited and included an infinite number of alkenyls, known and unknown, except for the two prior art compounds. More recent cases have endorsed negative limitations if there is nothing “inherently ambiguous or uncertain about the limitation” (see MPEP 2173.05(i)).

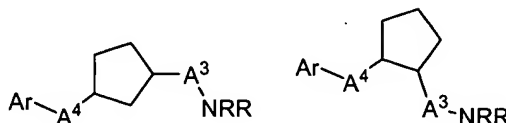
Claims 1 and 43 unambiguously define the scope of the invention and then qualify certain elements *within* the defined scope. Negative limitations within a defined claim scope is an acceptable practice and is not a basis for an indefiniteness rejection.

The applicants believe there is no basis for rejections based on indefiniteness and respectfully request the examiner to withdraw these rejections.

**Rejection under 35 USC 101.** The examiner provisionally rejected claims 1-10, 18, 23-42, and 44-47 for claiming the same invention as copending U.S. application 10/662,493. The applicants respectfully traverse.

The test for statutory double patenting is whether the same invention is being claimed twice, where the “same invention” means identical subject matter. *Miller v. Eagle Mfg.* 151 U.S. 186 (1984).

The current application claims compounds which are substituted in a 1,3 sense while application no. 10/662,493 claims compounds in a 1,2-sense.



As the subject matter in these applications is not identical, the applicants respectfully request the examiner withdraw the rejection based on statutory double patenting.

**Rejection under judicially created double patenting.** The examiner provisionally rejected claims 54 and 59 for obviousness-type double patenting over claims 43 and 48 copending U.S. application 10/662,493. The applicants traverse.

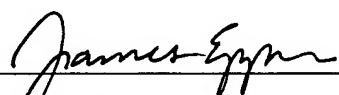
Judicially created double patenting is to prevent improper extension of a patent term and may be overcome by filing terminal disclaimers.

While the applicants do not concede that the inventions claimed in the two applications are patentably indistinct, the rejection is unwarranted because the two applications were filed on the same day and there is no patent term to disclaim. The applicants respectfully request the examiner to withdraw the rejection based on obviousness-type double patenting.

The applicants believe the application is now in allowable form and respectfully request favorable reconsideration. If any issues remain regarding the allowance of this application, the Examiner is respectfully invited to contact the applicants' agent, James Epperson, by phone (203-677-6974), fax (203-677-6900), or e-mail (james.epperson@bms.com).

Respectfully submitted,

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